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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,234	12/22/1999	DAVID L. SALGADO	D/99173	5920

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JOHN E BECK  
XEROX CORPPRATION  
XEROX SQUARE-20A  
ROCHESTER, NY 14644

EXAMINER
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HYEON, HAE M

ART UNIT	PAPER NUMBER
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2839

MAIL DATE	DELIVERY MODE
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09/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/470,234

Applicant(s)

SALGADO ET AL.

Examiner

Hae M. Hyeon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of the Group I in the reply filed on September 10, 2007 is acknowledged. The traversal is on the ground(s) that the subject matter of all claims is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. This is not found persuasive because the Group II is a method of communication involving specific order of steps for establishing a communication, while the elected Group I deals with a structure of an apparatus with intended purposes that do not require the specific order of steps recited in the Group II.

The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 10 recites, "A printing machine **capable of communicating through a transmission line that terminates with a connector**, comprising:". One interpretation of this preamble is that the transmission line with the connector is attached to the printing machine so that the printing machine can communicate through the transmission line

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with the connector. Then, with what that the printing machine is communication through the transmission line with the connector? If the connector is a part of the printing machine, than the printing machine is connection its own connector to its own receptacle.

The second interpretation of this preamble is that the transmission line with the connector is not part of the printing machine. Then, to what that the transmission line with the connector belongs

4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: **the device with the components of the apparatus, the transmission line terminated with the connector and the signal detector.**

According to the preambles of claims 1-3, the apparatus provides connection between the transmission line with the connector and the device. Since the apparatus has a receptacle for receiving the connector, it is clear how the apparatus is connecting with the transmission line. However, it is not clear how the apparatus is connecting with the device since claims 1-9 do not recite the structural relationship between the apparatus and the device.

Claim 4 recites the apparatus further comprising a signal detector, but claims 1 and 4-9 do not recite how the signal detector is structurally related with the receptacle and the sensor of the apparatus and the transmission line.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 4-6 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by German et al (US 6,499,861 B1).

German discloses an apparatus for connecting a transmission line 20 that terminates with a connector 22 to a device, comprising a receptacle 16 for receiving the connector 22; a sensor 38 associated with the receptacle for detecting the presence of the connector 22 within the receptacle 16; and a sensor circuit 34 communicating with the detecting sensor 38 for transmitting a signal indicating whether the detecting sensor 38 detects the presence of the connector 22.

7. Claims 1, 2, 4-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Bartolutti et al (US 6,350,148 B1).

Bartolutti discloses an apparatus for connecting a transmission line 20 that terminates with a connector 22 to a device, comprising a receptacle 16 for receiving the connector 22; and a

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sensor 38 associated with the receptacle for detecting the presence of the connector 22 within the receptacle 16. Bartolutti also discloses the sensor being a pressure switch 52 within the receptacle 16.

8. Claim 3 is rejected under 35 U.S.C. 102(e) as being anticipated by Scharf et al (US 6,497,588 B1).

Scharf discloses an apparatus 26 for connecting a transmission line 32 that terminates with a connector 31 to a device, comprising a receptacle 25' (see Figs. 7-10) for receiving the connector 32; and an optical sensor 70 associated with the receptacle 25' for detecting the presence of the connector 32 within the receptacle 25'.

9. Claims 1 and 4-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Recht et al. (US 5,841,851).

Recht discloses an apparatus 299 for connecting a transmission line 139 that terminates with a connector (same as the connector 135 that is on opposite end of the transmission line 139, which is not shown) to a device 170, comprising a receptacle 304 or 306 for receiving the connector; and a sensor 232 associated with the receptacle 304 for detecting the presence of the connector within the receptacle 304, 306. Note: Column 2, lines 5-24, teaches the lines are connected by the presence of the connector within the receptacle (Inserting the plug into the jack). Recht also discloses the apparatus further comprising a signal detector 246 for detecting a telephone dial tone signals communicated through the transmission line (see column 5, lines 45-60 and column 6, lines 37-45). In response to a signal from the sensor indicating that the connector is present within the receptacle, (column 8, lines 10-27 and 48-52) a determination is made, with the signal detector, whether signals (ringing signals) are being communicated through the transmission line (see 1202 in Fig. 12, column 3, lines 32- 38). In response to a

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failure by the signal detector to detect signals through the transmission line, (see 802, 804 in Fig. 8) a determination is made, with the sensor, whether the connector is present within the receptacle (see 808, 812 in Fig. 8). The sensor is utilized to determine whether the connector is present within the receptacle when the device is activated (see Fig. 8). The signal detector 232 is utilized to detect signals through the transmission line at times other than on device activation (see 1102 in Fig. 11, column 7, lines 60-67).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over German et al or Bartolutti et al.

Claims 6-9 recite an intended use of the sensor of the apparatus. While German and Bartolutti do not disclose the functions of the sensor recited in claims 6-9, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to apply any desired intended function for the sensor. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

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***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 4,224,485 by Krumreich, US Patent No. 4,699,443 by Goodrich et al., US Patent No. 5,599,209 by Belopolsky, US Patent No. 6,056,568 by Arnett and US Patent No. 6,885,478 B1 by Salgado et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hae M. Hyeon whose telephone number is 571-272-2093. The examiner can normally be reached on Mon.-Fri. (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tulsidas C. Patel can be reached on (571) 272-2098. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hae M Hyeon  
Primary Examiner  
Art Unit 2839

hnh

*hnh*

*Hae Moon Hyeon*